



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT(S) : Zofchak, et al.
SERIAL NO. : 09/933,108
FILED : August 20, 2001
FOR : POLYMERIC URETHANE ESTER QUATS AND THEIR USE IN
PERSONAL CARE PRODUCTS
GROUP ART UNIT : 1616
Examiner : Marin Lamm

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Commissioner for Patents
Washington, D.C. 20231

**Election of Invention in Response
to Restriction Requirement**

In response to the Examiner's correspondence dated November 1, 2002, pursuant to the Examiner's restriction requirement in the above-referenced patent application, Applicant provisionally elects with traverse to prosecute the invention of group II, claims 14-28 and 37-48, drawn to a composition and method of making same, classified in class 525, subclass 7+. In addition, Applicants provisionally elect with traverse to prosecute a composition comprising a polymeric urethane quat wherein the trialkanolamine is triethanolamine, the C₂ to C₂₅ acid is ricinoleic acid, the diisocyanate is isophorone diisocyanate and the quaternizing agent is diethyl sulfate. Claims 14-27 and 37, 38 and 40-48 are readable on the provisionally elected species. Although Applicants indicate the provisional election of the species in Group II and have set forth the claims readable on the elected species, Applicants respectfully request the Examiner to give consideration to also examining the invention set forth in Group IV, drawn to a personal care product comprising the compound of formula II, classified in 424, subclass 401. By examining all of the claims which are readable on the elected species, this will substantially enhance the efficiency of examining this patent application and the scope of the invention to which Applicants are entitled.

Claims 1, 4, 6, 9, 11, 14, 16, 17, 20, 22, 25, 27 and 30 of Invention Group II are readable on the elected species. Should the Examiner give favorable consideration to also examining the invention of Group IV, it is respectfully submitted that claims 51-56 also would be readable thereon. It is respectfully submitted that the provisionally elected species sufficiently narrows the

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issues which the Examiner is to consider during examination of this application and consequently, Applicants respectfully request the Examiner to give serious consideration to the examination of all of the claims requested, namely claims 1, 4, 6, 9, 11, 14, 16, 17, 20, 22, 25, 27, 30 and 51-56.

Notwithstanding Applicants election, Applicants respectfully traverses the Examiner's requirement for restriction. Applicant respectfully submits that prosecution of the originally filed claims should not be restricted to the elected invention.

According to M.P.E.P. §803, restriction by the Examiner of patentably distinct inventions is proper if the claimed inventions are independent and a serious burden would be placed on the Examiner if restriction was not required. Applicant respectfully submits that the presentation of the originally filed claims would not place such a serious burden on the Examiner as to require restriction. All of the originally filed claims are related, though patentably distinct polymeric chemical compositions and personal care products which comprise said compositions.

Although the claimed compositions are generally patentably distinct from each other, Applicant respectfully submits that any search the Examiner would need to conduct in examining the instant application would not be unduly burdensome. Moreover, the examination of all of the originally filed claims in the instant application would not place such a serious burden on the Examiner as to require restriction.

Applicant understands the general policy considerations for the Patent Office's requirement for restriction in certain instances. In this instance, however, those considerations do not weigh in favor of restricting the inventions here. In determining the appropriateness of restriction, one must also consider the countervailing consideration that, in each instance, Applicant wishes the Patent Office to examine his or her application with a certain degree of "administrative efficiency" and wishes to have patent claims issue which reflect the breadth of his or her invention.

Applicant respectfully submits that the originally filed claims are sufficiently narrow to allow the Examiner to determine patentability without being subjected to the serious burden referred to in M.P.E.P. §803. Note that the inventions of Groups I and II are both searchable in

the *identical class and subclass, namely class 525, subclass 7+*. Thus, any search which the Examiner must conduct in examining the invention of Group II, will necessarily overlap with any search the Examiner must conduct in examining the invention of Group I. The burden the Examiner would normally be subjected to in examining more than one invention is therefore ameliorated here where the inventions clearly overlap and only one class/subclass is to be searched. Consequently, Applicant respectfully requests that the Examiner withdraw the restriction requirement. Alternatively, Applicants respectfully request that the Examiner extend consideration to examining all of the claims of groups II and IV, which are readable on the elected species, or alternately all of the claims of groups I and II, inasmuch as the compositions in these inventive groups are found in the identical class and related subclass.

Respectfully submitted,

COLEMAN SUDOL SAPONE, P.C.

By: 

Henry D. Coleman

Reg. No. 32,559

714 Colorado Avenue

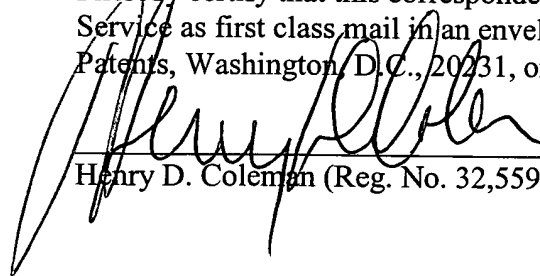
Bridgeport, Connecticut 06605-1601

(203) 366-3560

Dated: February 1, 2003

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Henry D. Coleman (Reg. No. 32,559)

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